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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,721	07/12/2000	Katsushi Matsuda	NEC-F82/USA	2343

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EXAMINER

NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/614,721

Applicant(s)

MATSUDA ET AL.

Examiner

Cindy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/22/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/12/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to amendment filed 09/02/05.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 2, 3-6, the word "means" is preceded by the word(s) "a data monitoring and content judging" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-6 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the functional descriptive material. The nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer readable medium, in a computer, on a electromagnetic carrier signal does not make it statutory.

In the present case, claims 2-6 and 8 only recites an abstract idea. The recites an information retrieval apparatus is not a process, machine, manufacture or composition of matter, the claims only refer to an information retrieval apparatus which is considered nonfunctional descriptive material and software per se, therefore non-statutory. According to the recitation a document retrieved from said database is a structured document or organized data and said retrieval screen is a pictorial a graphic or illustrative of organized data. Therefore, the recitation claimed to a data structure per se held nonstatutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wical (US 5953718) in view of Walls et al. (US 5848410) (Walls).

Regarding claim 2, Wical discloses: An information retrieval apparatus comprising: a data monitoring and content judging means for monitoring a document retrieved from a database in inferring a field to which this document belongs (col. 5, lines 59 to col. 6, lines 60, Wical);

A retrieval screen generating means for generating a retrieval screen for a user to perform a retrieval operation taking the inferred field as an object of retrieval (col. 15, lines 15-33, Walls) and outputting the retrieval screen as data to be displayed together with said retrieved document (col. 8, lines 63 to col. 9, lines 7, Wical).

However Wical didn't disclose: wherein document retrieved from said database is a structured document, Said retrieval screen is a screen of a structured document in which screen a retrieval part is embedded in the retrieval structured document and a user can retrieve. On the other hand, Walls disclose: wherein document retrieved from said database is a structured document (col. 24, lines 60 to col. 25, lines 33, Walls);

Said retrieval screen is a screen of a structured document in which screen a retrieval part is embedded in the retrieval structured document and a user can retrieve (col. 23, lines 20

to col. 25, lines 33, Walls). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include wherein document retrieved from said database is a structured document, Said retrieval screen is a screen of a structured document in which screen a retrieval part is embedded in the retrieval structured document and a user can retrieve in the system of Wical as taught by Walls. The motivation being to capability allows the user to specify a search word and presented with a search report in HTML format that indicates which of the files in the file system contains the search characters.

Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 2 above. In addition, Wical/Walls discloses: said retrieval screen is a screen of a structured document in which screen a retrieval part is separate in the retrieval structured document and a user can retrieve (col. 24, lines 60 to col. 25, lines 33, Walls).

Regarding claims 4 and 8, all the limitations of this claim have been noted in the rejection of claims 2 and 3 above, respectively. In addition, Wical/Walls discloses: wherein output of said retrieval screen generating means is supplied to an input/output means for retrieving and displaying a document stored in said database (col. 25, lines 34 to col. 26, lines 25, Walls); and said input/output means displays a retrieval screen outputted by said retrieval screen generating means and retrieval again another document stored in said database by a retrieval operation performed by a user according to this retrieval screen (col. 25, lines 34 to col. 26, lines 25, Walls).

Regarding claim 5, all the limitations of this claim have been noted in the rejection of claim 2 above. In addition, Wical/Walls discloses: said data monitoring and content judging means infers a field to which the structured document belongs (col. 5, lines 59 to col. 6, lines 60, Wical), using as a criterion of judgment either one or both of the content of text data contained in the structured document and the number of links (col. 17, lines 57 to col. 18, lines 18, Wical).

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 2 above. In addition, Wical/Walls discloses: wherein a document retrieved from said database is given in advance the information for identifying its field (col. 24, lines 60 to col. 25, lines 33, Walls); said data monitoring and content judging means notifies said retrieval screen generating means of a field represented by said identifying information (col. 10, lines 1-36, Ishikawa).

Regarding claim 7, all the limitations of these claims have been noted in the rejection of claims 2 and 4. It is therefore rejected as set forth above.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4023. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the


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organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Cindy Nguyen
December 9, 2005


FRANTZ COBY
PRIMARY EXAMINER